

Patent Prosecution: Final Rejections

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A Practice Note discussing US Patent and Trademark Office (USPTO) patent examiner final office actions issued during patent prosecution of a utility patent application and a patent applicant's options for responding to final rejections.

This Note discusses responding to US Patent and Trademark Office (USPTO) final office actions during patent prosecution of utility patent applications.

USPTO patent examiners review patent applications to determine if they meet the Patent Act's requirements. Broadly, prosecution typically includes the examiner issuing:

- A first office action on the merits objecting to or rejecting one or more of the application's claims.
- Following the applicant's response, a second office action finally rejecting one or more claims.

This Note discusses the applicant's limited response options after final rejection and considerations for selecting and executing the best approach for the situation.

The USPTO's examiner training [webpage](#) provides specific examiner training on [After Final Practice and Request for Continued Examination \(RCE\)](#).

For more information on patent prosecution generally, see [Practice Note, Patent Prosecution: Overview](#).

Overview of Final Office Actions

With certain exceptions, the USPTO generally designates the second and subsequent office actions in a patent application as final (37 C.F.R. § 1.113(a); see [Final Second and Subsequent Office Actions](#)). The first office action may be made final in limited circumstances (see [Final First Office Actions](#)).

When the examiner issues a final office action:

- Substantive prosecution on the finally rejected claims is closed.

- The applicant cannot, as a matter of right:
 - amend the claims or add new claims; or
 - reinstate previously canceled claims.

(37 C.F.R. § 1.113(a); see *Intra-Cellular Therapies, Inc. v. Iancu*, 938 F.3d 1371, 1375–76 (Fed. Cir. 2019); MPEP § 714.13(II).)

Responses to final office actions are due within a variable reply period (see [Variable Three-Month Reply Period](#)).

Final Second and Subsequent Office Actions

The examiner may issue multiple non-final office actions but typically designates the second office action as final (37 C.F.R. § 1.113(a)). Under current USPTO policy, a patent examiner must designate any second or later office action on the merits as final, except when the office action introduces a new ground of rejection:

- Not resulting from the applicant's claim amendments. Therefore, if the applicant's amendment results in the examiner issuing a new ground of rejection, the examiner can designate as a second or later rejection as final.
- Not based on information cited in an information disclosure statement (IDS) filed during the period described in 37 C.F.R. § 1.97(c) with the fee under 37 C.F.R. § 1.17(p). For more information on IDS practice, see [Practice Note, Patent Prosecution: USPTO Duty of Candor and Information Disclosure: Filing an IDS After an Office Action](#).

(MPEP § 706.07(a).)

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Examples of a new ground of rejection include situations where the examiner:

- Changes the rejection's statutory basis, such as from 35 U.S.C. § 102 anticipation to 35 U.S.C. § 103 obviousness, or from obviousness to anticipation relying on a different prior art teaching.
- Cites new calculations to support a rejection based on overlapping ranges.
- Cites different teachings or structure to support a structural obviousness rejection.

(MPEP § 1207.03(a).)

If the rejection's basic thrust remains the same, it is not a new ground of rejection. This is true, for example, where the examiner:

- Cites a different portion of a reference to elaborate on a previous citation.
- Changes the rejection's statutory basis from obviousness to anticipation but relies on the same teaching.
- Relies on fewer prior art references cited in support of a 35 U.S.C. § 103 rejection but relies on the same teaching.
- Changes the order of references in the rejection's analysis but relies on the same teaching.
- Considers other portions of a reference the applicant submitted to respond to the applicant's arguments.

(MPEP §§ 706.07(a) and 1207.03(a).)

If the applicant files a common ownership statement to disqualify a reference under 35 U.S.C. § 102(b)(2)(C) in response to a 35 U.S.C. § 102(a)(2) rejection without amending the claims, the examiner may not make a new rejection final. However, the examiner may designate as final a new double patenting rejection based on a reference disqualified under 35 U.S.C. § 102(c) even if the applicant did not amend the claims. (MPEP § 706.07(a).)

For information on common ownership statements, see [Practice Note, Prior Art: Exceptions for Commonly Owned and Joint Research Agreement Patent Documents: Patent Prosecution: Disqualifying Section 102\(a\)\(2\) Prior Art](#).

Final First Office Actions

The examiner may designate a first office action as final in a continuing patent application or the after

a request for continued examination (RCE) if the claims both:

- Are identical to, claim the same invention as, or have unity of invention with, the claims in the parent application or before the RCE.
- Would be properly finally rejected on the grounds and art of record in the next office action if they had been entered in the parent application or before the RCE.

In practice, the examiner may be more likely to issue a first office action as final in an RCE as compared to a continuing application.

However, a final first office action is improper in:

- A continuing patent application or an RCE if that application contains material presented in an earlier application after a final rejection or the close of prosecution but was not entered because the material raised:
 - new issues requiring the examiner to further consider the claims or conduct additional prior art searching; or
 - a new matter concern.
- A continuation-in-part application if a claim includes subject matter not in the earlier application.

(MPEP § 706.07(b).)

Responding to Final Office Actions

After issuing a final office action, the examiner need not further examine and review the application and the applicant's arguments (MPEP § 714.12). The applicant's limited options after final rejection include filing:

- A response after final rejection under 37 C.F.R. § 1.116 (see [Responses and Amendments After Final Rejection](#)). The response due date is based on a variable reply period (see [Variable Three-Month Reply Period](#)).
- An RCE (37 C.F.R. § 1.114; see [Request for Continued Examination](#)).
- A notice of appeal (37 C.F.R. § 41.31; see [Appeal](#)).
- A new continuing patent application, instead of or in addition to filing a response (see [Filing a Continuing Application](#)).

Instead of immediately filing a response, counsel should consider an examiner interview (MPEP §§ 706.07(f) (III) and 713.09). Examiners are not required to grant a formal interview after final rejection but are generally willing to answer basic questions about the office action by telephone. For information on examiner interviews, see [Practice Note, Patent Prosecution: Examiner Interviews](#). Counsel may also prepare for a possible appeal (see Appeal).

Where the office action's finality is improper (see Overview of Final Office Actions), the applicant can seek reconsideration or file a petition (see Challenging an Office Action Improperly Made Final).

If the final action does not address or respond to one or more of the applicant's response arguments, counsel can file a petition to withdraw the action (37 C.F.R. § 1.181; see [Practice Note, Patent Prosecution: 37 C.F.R. § 1.181 Petitions for a Complete Office Action](#)). However, the petition will not toll the period for reply (37 C.F.R. § 1.181(f)).

The former [After Final Consideration Pilot Program \(AFCP\) 2.0](#) terminated in December 2024.

Responses and Amendments After Final Rejection

The applicant may file a response under 37 C.F.R. § 1.116 after a final office action. However, examiners typically only enter amendments that require no further search and:

- Cancel claims.
- Adopt the examiner's suggestions concerning obtaining allowable claims.
- Reflect any agreement the examiner and patent counsel reached in an interview.
- Place the rejected claims in better form for appeal, such as by resolving a claim objection, antecedent basis issue, or simple Section 112 issue.
- Require only the examiner's cursory review with no need for an updated prior art search.

(37 C.F.R. §§ 1.113(c) and 1.116(b); MPEP §§ 714.12 and 714.13.)

If the examiner issues an advisory action after response indicating that the application is not in condition for allowance, counsel should consider alternative response options or a continuation application. Counsel should also note that a

final office action response that does not lead to allowance may reduce any patent term adjustment (PTA) (see [Practice Note, Patent Term Adjustment: After-Final Practice and Appeal](#) and [Legal Update, Improper Reply to Final Office Action Constitutes Applicant Delay for Patent Term Adjustment: Federal Circuit](#)).

Variable Three-Month Reply Period

The statutory deadline for replying to a final office action is six months after the notification date. However, the action typically sets a shortened three-month response period (35 U.S.C. § 133; MPEP § 706.07(f)). If the applicant files a response under 37 C.F.R. § 1.116 to a final action within two months that does not place the application in condition for allowance, the shortened response period expires on the later of:

- The shortened three-month response period identified in the final rejection.
- The notification date of an advisory action issued in response to the applicant's final rejection response. This saves the applicant from having to pay extension of time fees while the examiner considers an amendment after final.

(MPEP §§ 706.07(f) and 714.13 (I).)

The applicant can obtain extensions of time under 37 C.F.R. § 1.136(a) up to the statutory deadline, for example to:

- Address issues the advisory action raises.
- Avoid the application's abandonment.

(MPEP § 706.07(f).)

Unlike a timely filed response to a non-final office action:

- A response to a final office action does not automatically toll the statutory response period.
- The applicant must take further action to avoid the application's abandonment if the after-final response does not put the application in condition for allowance.

(37 C.F.R. §§ 1.116(c) and 1.135(b); see Responses and Amendments After Final Rejection.)

Request for Continued Examination

A timely filed RCE:

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Continues the original application's examination, except for any claims that are directed to a different invention from the previously examined claims. These claims will not be entered but presenting them preserves the right to pursue them in a subsequent divisional application.

- Results in the examiner's:
 - withdrawal of the previous office action's finality; and
 - consideration of the submission.

(37 C.F.R. § 1.114(d); MPEP § 706.07(h).)

Filing an RCE requires:

- A request.
- A submission (see RCE Submission).
- The fee under 37 C.F.R. § 1.17(e). Counsel should also authorize payment of any additional fees including any:
 - excess claim fees under 37 C.F.R. § 1.16(h) and (i) if they file additional claims with the RCE; and
 - extension of time fees under 37 C.F.R. § 1.17(a) for any extension of time requests under 37 C.F.R. § 1.136.

(37 C.F.R. § 1.114; MPEP § 706.07(h).)

Although an RCE may be an efficient way to require the examiner to consider a previously filed but unentered amendment, patent counsel should also consider the potential loss of PTA (35 U.S.C. § 154(b) (2); 37 C.F.R. § 1.704(c)(12)). If PTA is important, filing an appeal may be a better option. For more information on PTA, see [Practice Note, Patent Term Adjustment](#).

For more information on RCEs, see [Practice Note, Patent Prosecution: Continuing Patent Applications: Request for Continued Examination](#) and [Request for Continued Examination \(RCE\) Checklist](#).

RCE Submission

The RCE submission may include:

- An IDS, which the examiner will consider.
- An amendment to the written description, claims, or drawings. A previously filed amendment satisfies the RCE submission requirement. Examiners will enter any previously filed but unentered amendment when processing the RCE. Counsel should provide instructions concerning entry of

any previously filed amendment to avoid confusion although the USPTO prefers counsel to file an amendment with the RCE request and instructions to not enter the previously unentered amendment.

- A new argument supporting patentability.
- New evidence, such as a declaration under 37 C.F.R. § 1.132, supporting patentability. Counsel may consider filing a request to suspend the RCE's prosecution for up to three months in certain circumstances, such as when the applicant needs additional time to generate data for a declaration to rebut the examiner's previous final rejection (37 C.F.R. § 1.103(c)).

(37 C.F.R. § 1.114(c); MPEP § 706.07(h).)

If the response is incomplete but still a bona fide attempt to reply fully to the final office action, the examiner will notify counsel and provide a new two-month period to file the complete reply. Examples of bona fide attempts to fully reply include:

- An amendment that does not comply with 37 C.F.R. § 1.121 concerning the manner of making an amendment but is an attempt to completely reply to the previous office action.
- New or amended claims directed to a different invention (37 C.F.R. § 1.145) that the examiner deems constructively not elected.

If the submission is not a bona fide attempt to fully reply to the final office action, the period for reply is not tolled and the application becomes abandoned no later than six months after the final office action's notification date. Examples of filings that are not bona fide attempts to completely reply to the final office action include:

- An IDS with no other attempt to provide a complete reply to the final office action.
- An amendment canceling all pending claims without presenting any new or substitute claims.

(MPEP § 706.07(h) (VI).)

Appeal

The applicant may also appeal an examiner's final rejection to the Patent Trial and Appeal Board (PTAB). An applicant may appeal claim rejections:

- If the examiner has twice rejected the claims (35 U.S.C. § 134(a); MPEP § 1204). Claims drawn to similar subject matter are considered twice

rejected in a continuation application at the first action even if the rejection is labeled a non-final action (MPEP § 1204(I), (II)).

- By filing a notice of appeal (see [USPTO Form PTO/AIA/31](#)) and the required fee (37 C.F.R. § 41.20(b)(1)).

While an appeal can delay the patent's issuance, counsel should consider an appeal if:

- The examiner's rejections are clearly erroneous for at least one claim.
- Further claim amendment:
 - cannot overcome the rejection;
 - would make the claims less commercially valuable; or
 - would require filing of a continuing application that would trigger the continuing application fee for applications filed after six and nine years after the original application (see [Practice Note, Patent Prosecution: Continuing Patent Applications: Additional Fees for Continuing Applications Filed After More Than Six and Nine Years](#)).
- Patent counsel can use the delay inherent to the appeal process to advance their client's interests (see [Practice Note, Patent Prosecution: PTAB Appeals: Submissions Allowed After Notice of Appeal](#)).

An ex parte appeal prosecuted to a final decision can be a lengthy and costly proceeding. However, USPTO data indicate that only about 30% of appeals result in a PTAB decision, meaning that the applicant usually avoids the time and expense of fully briefing an appeal. The Pre-Appeal Brief Conference Program can be part of a strategy to obtain allowance or reopening of prosecution. Under this program, the appellant files a five-page pre-appeal brief request for review that three examiners review. If the request convinces the panel that the claims are allowable, the applicant avoids the need to file an appeal brief. If not, the applicant can still continue the appeal. (MPEP § 1204.02.) If an appeal is successful for at least one claim in the application, existing PTA can be preserved and additional PTA gained for the period of time the appeal is docketed pending consideration by a PTAB panel.

For more information on patent application prosecution appeals, see [Practice Note, Patent Prosecution: PTAB Appeals](#) and [Patent Prosecution Flowcharts](#).

Filing a Continuing Application

Instead of filing an RCE, the applicant can file a continuing patent application claiming the benefit of the finally rejected application's filing date. This allows the continued prosecution of both the original application and the continuing patent application instead of resulting in the continued prosecution of a single pending application, which occurs when filing an RCE.

A continuing patent application:

- Is a new patent application, which allows the applicant to include claims:
 - finally rejected in the parent application; and
 - further amended beyond the finally rejected claims in the parent application, such as in an unentered response to a final rejection.
- Claims the benefit of the parent application's filing date so the scope of prior art does not increase.

(35 U.S.C. § 120; 37 C.F.R. § 1.78(d); MPEP § 201.07.)

For more information on continuing patent applications, see [Practice Note, Patent Prosecution: Continuing Patent Applications](#). For more information on domestic benefit claims, see [Practice Note, Patent Prosecution: Domestic Benefit and Foreign Priority Claims: Continuing Application Domestic Benefit Claim Requirements](#).

The USPTO has historically examined patent applications according to their priority date, resulting in earlier examination for a continuing application compared to an original application filed on the same date. However, the USPTO can track applications for examination based on their actual filing date, so counsel should be aware of the policy at the time of filing. Additionally, PTA limitations may adversely affect the continuing patent's term (37 C.F.R. § 1.704(c)(14)). For more information, see [Practice Note, Patent Term Adjustment](#).

Challenging an Office Action Improperly Made Final

If counsel believes the final rejection is premature, the response should request reconsideration and withdrawal of the action's finality (MPEP § 706.07(c)).

Alternatively, the applicant can challenge an office action improperly made final by petition under

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37 C.F.R. § 1.181 (MPEP § 706.07(c)). A potential challenge is that a petition does not toll the period for response to the office action. Applicants should file the petition as soon as possible to reduce the likelihood of it being rendered moot by the office action response deadline. If the petition is not filed within two months after the final action, it is unlikely that the primary examiner will decide on the petition within sufficient time before the applicant is forced to appeal or file an RCE.

Final Rejection Scenarios and Response Considerations

When determining how to respond to a final rejection, patent counsel should consider:

- The finally rejected claims and the strengths or weaknesses of the examiner's arguments.
- How the pending application fits in the applicant's broader patent portfolio and strategy. For more information on patent portfolio development, see [Practice Note, Patent Portfolio Development and Management](#).
- Whether additional evidence is needed to support the claims' patentability, including inventor declarations (see [Practice Note, Patent Prosecution: Section 103 Prior Art Obviousness Rejections \(Unpredictable Technologies\): Submitting Patentability Evidence](#)).
- Ways to overcome double patenting rejections that can be resolved before appeal (see [Practice Note, Double Patenting: Responding to USPTO Double Patenting Rejections: General Considerations](#)).
- Whether the final action includes any petitionable issues like claim, specification, or drawing objections (see MPEP § 1002).

If counsel believes:

- The rejection's finality is improper, they should respond to the final office action by way of a

petition to withdraw the office action's finality (see [Responding to Final Office Actions](#)).

- The final office action is unreasonable, counsel may consider appealing the final office action rejections to the PTAB if patent counsel believes they can demonstrate the pending claims' allowability (see [Appeal](#)).
- Only minor amendments are necessary to place the claims in condition for allowance, an amendment after final rejection can be the best approach (see [Responses and Amendments After Final Rejection](#)). If the examiner does not enter the amendment, filing an RCE is a fallback option (see [Request for Continued Examination](#)).

If the final office action allows some claims, and the rejected claims are likely to be allowable with further amendment, evidence, or argument, counsel should consider both:

- Accepting the allowed claims for issuance in the application and canceling the rejected claims from the application.
- Filing a continuing patent application containing the rejected claims from the parent application, including whether a new continuing application would trigger a benefit claim fee for filing a continuing application more than six or nine years after the priority date (see [Practice Note, Patent Prosecution: Continuing Patent Applications: Additional Fees for Continuing Applications Filed After More Than Six and Nine Years](#)).

This continuation strategy has several benefits and disadvantages, including:

- Quicker patent issuance of at least some claims without unnecessary prosecution history in the original application.
- Potential double patenting issues raised by the continuing application.
- Additional filing, prosecution, issue, and maintenance fees.

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